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09/638,457	08/14/2000	Eric Boyd	18567-0012	9536

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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/638,457

Applicant(s)
Boyd et al

Examiner
James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 30, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 24-70 is/are pending in the application.
- 4a) Of the above, claim(s) 27-37 and 60-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 24-26, and 38-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. The amendment filed on July 30, 2003 under 37 CFR 1.111 is sufficient to overcome the Kamille (5,996,997) reference.

The amendment canceled the non-elected claims 9-23 and added new claims 24-70. The currently pending claims are claims 1-8 and 24-70. However, as noted below, claims 27-37 and 60-70 are withdrawn from consideration. Thus, the claims currently under consideration are claims 1-8, 24-26, and 38-59.

Election/Restriction

2. Newly submitted claims 27-37 and 60-70 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Applicant is attempting to incorporate the non-elected invention of canceled claims 9-23 by making them dependent upon the elected invention. However, as stated in the Election/Restriction requirement in paragraph 2 of paper number 3, the two inventions are related as a combination and subcombination which may be used separately.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the

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merits. Accordingly, claims 27-37 and 60-70 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

3. Claim 46 is objected to because of the following informalities:

Claim 46 is dependent upon itself. The Examiner believes this is a typographical error and that the claim should depend upon Claim 43. The claim will be considered as such. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b).

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Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 38-40, 43, 44, 46, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggleston et al (6,061,660).

Claims 38 and 43: Eggleston discloses a system for earning and redeeming incentive points, comprising:

- a. A network with multiple servers (Figure 1); and
- b. A user database of user accounts holding incentive points earned by the user (col 35, lines 26-37) by interacting with the servers (col 35, lines 12-20 and 26-29).

Claims 39 and 44: Eggleston discloses a system for earning and redeeming incentive points as in Claims 38 and 43 above, and further discloses the user obtaining a code offline and the interacting with the servers comprises submitting the code (col 36, lines 20-39).

Claims 40 and 46: Eggleston discloses a system for earning and redeeming incentive points as in Claims 38 and 43 above, and further discloses that the interacting with the servers comprises registration, attention to an ad, or a purchase (col 35, lines 21-67).

Claim 48: Eggleston discloses a system for earning and redeeming incentive points as in Claim 43 above, and further discloses the network and servers are the Internet and an Internet server (col 7, lines 18-25 and col 8, lines 21-24).

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8, 24-26, and 50-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamille (5,996,997) in view of Eggleston et al (6,061,660).

Claims 1 and 50: Kamille discloses a system for an awards points account, comprising:

- a. A main server for providing a user with an interface to submit a code obtained offline and associated with a prize(col 3, lines 18-35 and col 12, lines 31-41); and
- b. A code server for maintaining valid codes and verifying the validity of the code submitted by the user (col 3, lines 18-35 and col 12, lines 31-41).

Kamille does not explicitly disclose that the prize is a number of purchase or incentive points, nor that the user's account is increased by the number of points if the code is valid (i.e. a winning code). However, Eggleston discloses a similar system and method for an awards point account in which the prize for submitting a winning code is a number of loyalty points which are accumulated in the user's award account (col 35, lines 26-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to present points as prizes in Kamille and to accumulate these points in a user account. One would have been to

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award points instead of cash in order to decrease the need for the redemption facility to carry large amounts of cash (i.e. decrease the risk of theft) as described by Eggleston (col 42, lines 33-67) and to allow the user to qualify for a larger prize by repeated use of the system to increase the balance in the user account.

Claims 2-4: Kamille and Eggleston disclose a system for an awards points account as in Claim 1 above, and Eggleston further discloses maintaining a user account containing the points balance for the user and updates the user account after the user submits a valid code (col 35, lines 26-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to maintain and update the balance of the user account in Kamille in order to keep the account as current as possible.

Claims 5-8: Kamille and Eggleston disclose a system for an awards points account as in Claim 2 above, and Kamille further discloses that the code may contain any number of letters, numbers, and/or characters (col 13, lines 18-27).

Claims 24 and 51: Kamille and Eggleston disclose a system for an awards point account as in Claims 1 and 50 above, and Eggleston further discloses placing the user account behind a firewall and using passwords to increase the security of the account data. While it is not explicitly disclosed that the account data will also be encrypted, encryption is a well known security measure used to protect data and, thus, would have been an obvious addition to the security measures disclosed by Eggleston. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the use account data in Kamille. One

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would have been motivated to use encryption in order to prevent unauthorized disclosure of the information, especially if duplicate data was being stored on a smart card carried by the user as disclosed by Eggleston.

Claims 25 and 58: Kamille and Eggleston disclose a system for an awards point account as in Claims 1 and 50 above, and Kamille further discloses a means for generating the code and fixing the code onto an offline medium (such as a scratch ticket)(col 13, lines 18-27).

Claims 26 and 59: Kamille and Eggleston disclose a system for an awards point account as in Claims 25 and 58 above, and Kamille further discloses printing the code onto the offline medium (col 12, lines 42-44). However, neither reference explicitly discloses that the offline medium is a bottle cap. Official Notice is taken that it is old and well known within the marketing art to incorporate incentive playing pieces onto products or their containers, such as inside bottle caps, on the sides of plastic or paper food and beverage containers, inside candy wrappers, etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the code on the inside of a bottle cap. One would have been motivated to print the code on the bottle cap in order to prevent an unauthorized person from removing the code without purchasing the product.

Claim 52: Kamille and Eggleston disclose a method for an awards point account as in Claim 50 above and disclose several methods of redeeming the award points, but do not explicitly disclose that the points can be redeemed as payment for winning an auction. However, Eggleston does disclose that the incentive points may be many types of award units (to include "dollars")

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which may be turned in to "purchase" products. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user to use award units to purchase items for which a winning bid had been submitted and to allow the user to send the item to a third party as a gift.

Claims 53 and 54: Kamille and Eggleston disclose a method for an awards point account as in Claim 52 above, but do not explicitly disclose the type of auction. The Examiner notes that the claimed auction types are all well known types of auctions. Furthermore, the type of auction being conducted has no effect whatsoever on the claimed system of accumulating and redeeming incentive points. Thus, little patentable weight is given to the type of auction or how the auction is run. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to know that any method of determining an item to purchase for which the award points would be redeemed could be used, to include any type of auction, since the procedure has no connection to the incentive awards method.

Claims 55-57: Kamille and Eggleston disclose a method for an awards point account as in Claim 50 above, and Eggleston further discloses adding or subtracting points from the account based on the users interaction (point-actionable event) with the system; thus, maintaining a user account containing the points balance for the user and updates the user account after the user submits a valid code (col 35, lines 26-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to maintain and update the balance of the user account in Kamille in order to keep the account as current as possible.

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8. Claims 41, 42, 45, 47, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al (6,061,660).

Claims 41 and 47: Eggleston discloses a system for earning and redeeming incentive points as in Claims 38 and 43 above, but does not explicitly disclose that the points can be redeemed as payment for winning an auction. However, Eggleston does disclose that the incentive points may be many types of award units (to include “dollars”) which may be turned in to “purchase” products. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user to use award units to purchase items for which a winning bid had been submitted.

Claims 42, 45, and 49: Eggleston discloses a system for earning and redeeming incentive points as in Claims 38 and 43 above, and further discloses placing the user account behind a firewall and using passwords to increase the security of the account data. While it is not explicitly disclosed that the account data will also be encrypted, encryption is a well known security measure used to protect data and, thus, would have been an obvious addition to the security measures disclosed by Eggleston. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the use account data in Eggleston. One would have been motivated to use encryption in order to prevent unauthorized disclosure of the information, especially if duplicate data was being stored on a smart card carried by the user as disclosed by Eggleston.

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Response to Arguments

9. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

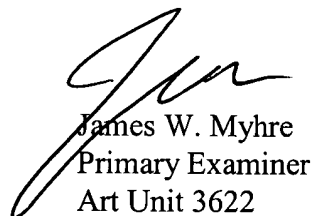
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM
September 8, 2003



James W. Myhre
Primary Examiner
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